
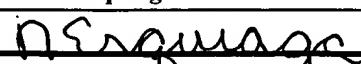


AF/3623 IFW

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application No.	08/882,197
		Filing Date	June 25, 1997
		First Named Inventor	Paul Greer
		Art Unit	3623
		Examiner Name	Susanna M. Diaz
Total Number of Pages in This Submission	60	Attorney Docket Number	42390P4072

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">2 copies of Appeal Brief</div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Eric T. King, Reg. No. 44,188 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	May 28, 2004

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.			
Typed or printed name	Nicole Erquiaga		
Signature		Date	May 28, 2004



FEE TRANSMITTAL for FY 2004

Effective 01/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 330.00

Complete if Known

Application Number 08/882,197
Filing Date June 25, 1997
First Named Inventor Paul Greer
Examiner Name Susanna M. Diaz
Art Unit 3623
Attorney Docket No. 42390P4072

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account

Deposit Account Number 02-2666

Deposit Account Name Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or underpayment of fees as required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES

Total Claims - 51** = X =
Independent Claims - 3 = X =
Multiple Dependent =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple Dependent claim, if not paid	
1204	86	2204	43	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)

**or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

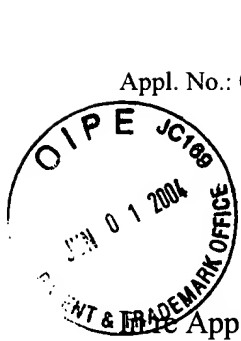
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Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920 *	1804	920 *	Requesting publication of SIR prior to Examiner action	
1805	1,840 *	1805	1,840 *	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1404	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	1809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					
SUBTOTAL (3)					(\$) 330.00

* Reduced by Basic Filing Fee Paid

SUBMITTED BY

Complete (if applicable)

Name (Print/Type) Eric T. King Registration No. (Attorney/Agent) 44,188 Telephone (714) 557-3800
Signature [Signature] Date 05/28/04



Appl. No.: 08/882,197

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Paul Greer et al.

Application No.: 08/882,197

Filed: June 25, 1997

For: **USER DEMOGRAPHIC PROFILE
DRIVEN ADVERTISING TARGETING**

Examiner:

Art Group:

APPEAL BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits, in triplicate, the following Appeal Brief pursuant to 37 C.F.R. § 1.192 for consideration by the Board of Patent Appeals and Interferences (hereinafter the Board).

Appellant also submits herewith our check number 31214 in the amount of \$330.00 to cover the cost of filing the opening brief as required by 37 C.F.R. § 1.17(f). Please charge any additional fees or credit any overpayment to our deposit Account No. 02-2666. A duplicate copy of the Fee Transmittal is enclosed for this purpose.

06/03/2004 MAHMED1 00000008 08882197

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Intel Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57 of the present application are pending and remain rejected. The Appellant hereby appeals the rejection of claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57.

IV. STATUS OF AMENDMENTS

The Appellant filed an amendment on December 2, 2003, in response to a Final Office Action issued by the Examiner on October 29, 2003. In response to the Appellant's amendment, the Examiner issued an Advisory Action on March 26, 2004. The Appellant filed a Notice of Appeal from the Advisory Action issued by the Examiner on March 30, 2004.

V. SUMMARY OF INVENTION

With reference to Figure 1, embodiments of the invention relate to a system including a target computer 112, 116, 120 to receive a content including an advertisement from a content provider 104 coupled to the target computer via a network (e.g. communication medium 108, server 124, router 128, etc.) to transmit the content.¹

¹ See Specification, page 6, lines 3-18.

Continuing with reference to Figure 1, the content provider 104 includes a user rule page 140 containing information automatically obtained from the target computer 112 by a first agent.² The first agent may have a trigger program to filter information and to determine whether the information is relevant to the user rule page 140.³

The content provider 104 further comprises a rule book 136 to provide a rule based on the user rule page 140 in which the rule controls the content to be transmitted from a database 132 to the target computer 112.⁴

With reference now to Figure 2, Figure 2 illustrates one embodiment of a rule page 200 associated with a user profile.⁵ For example, the rule may be stored in the form of a condition-action pair. The user rule page 200 includes at least one of a hardware profile 210 indicating the hardware capabilities of the target computer, a software profile 212 indicating software used by the target computer, and a user profile 216 including dynamic information related to a user using the target computer in which the dynamic information includes information on web-sites visited and time spent by the user on the web-sites (238, 242).⁶

With reference also to Figure 3, a second agent of (e.g. a content agent) updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer (blocks 332, 336).⁷

VI. ISSUE

The issue is:

² See Specification, page 6, lines 18-27 through page 7, lines 1-2.

³ See Specification, page 11, lines 1-8.

⁴ See Specification, page 6, lines 18-27 through page 7, lines 1-2.

⁵ See Specification, page 7, lines 17-18.

⁶ See Specification, page 7, lines 18-27, page 8, lines 1-20.

⁷ See Specification, page 11, lines 18-16 through page 12, lines 1-2.

Whether claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49 and 54-57 are unpatentable under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent No. 6,279,112 B1 issued to O'Toole Jr. et al., in view of U.S. Patent No. 5,796,952 issued to Davis et al., and further in view of what would have allegedly been known to one of ordinary skill in the art at the time of the invention (i.e. Official Notice).

VII. GROUPING OF CLAIMS

Appellant contends that the claims of the present invention stand or fall together. In other words, claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 form a single group.

VIII. ARGUMENTS

A. Arguments Directed to the Allowance of the Claims of Group I (Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57)

As set forth in the Final Office Action mailed October 29, 2003, claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 stand rejected under 35 U.S.C. §103(a). Appellant respectfully traverses the Final Office Action's obviousness rejections in their entirety and respectfully requests the Board reverse these rejections, for the reasons set forth below.

As stated in MPEP §2141.03:

A prima facie obviousness rejection requires the three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references of themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP §2141.03. (Emphasis added).

MPEP §2141.03 further warns that *impermissible hindsight must be avoided*.

Furthermore, with regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. *However, identification in the prior art of each individual part claimed is*

insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. (Emphasis added).

As set forth in the Final Office Action, claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 presently stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,279,112 B1 issued to O'Toole Jr. et al. (hereinafter O'Toole) in view of U.S. Patent No. 5,796, 952 issued to Davis et al. (hereinafter Davis), and further in view of what would have allegedly been known to one of ordinary skill in the art at the time of the invention (i.e. Official Notice).

Appellant respectfully submits that the limitations of independent claims 3 and 17 are not taught, suggested, or rendered obvious by O'Toole in combination with Davis, and further in combination with, what the Examiner alleges would have been obvious to one of ordinary skill in the art (i.e. Official Notice). As will be discussed, Appellant respectfully submits that the Examiner is utilizing *impermissible hindsight* to piece together disparate sections of the O'Toole and Davis references, along with what would have allegedly been obvious to one of ordinary skill in the art to, in hindsight, approximate Appellant's claimed invention, when in fact these disparate sections do not even teach or suggest Appellant's claim limitations.

Both of Appellant's independent claims 3 and 17 generally relate to a system comprising a target computer to receive a content including an advertisement, in which the content provider comprises: *a user rule page* containing information *automatically obtained from the target computer by a first agent having a triggering program to filter information and to determine whether the information is relevant to the user page...* *a rule book* to provide a rule based on the user rule page...the rule controlling the content to be transmitted from a database to the target computer and in which the rule is stored in the form of a condition/action pair...*the user rule page including at least one of a hardware profile* indicating the hardware capabilities of the target computer, *a software profile* indicating software used by the target computer, and *a user profile including dynamic information* related to a user using the target computer in which the dynamic information includes information *on web-sites visited and time spent by the user on the web-sites...* and wherein *a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds*

new appropriate content including a second advertisement that is transmitted to the target computer.

On the other hand, as set forth in the Abstract of O'Toole, O'Toole generally teaches: "The present invention relates to techniques for controlling transfers of information in computer networks. One technique involves transmitting from a server computer to a client computer, a document containing a channel object corresponding to a communication service, and storing an access ticket that indicates that a user of the client computer permits the information source computer to communicate with the user over a specified channel. Another technique involves transmitting smart digital offers based on information such as coupons and purchasing histories stored at the computer receiving the offer..."

Appellant respectfully submits that, contrary to the Examiner's assertion, O'Toole does not teach a first agent, and particularly, does not teach a user rule page containing information automatically obtained from the target computer by a first agent having a trigger program to filter information and to determine whether the information is relevant to the user rule page.

However, in an attempt to teach these limitations, the Examiner cites column 7, line 24 through column 8, line 4 of the O'Toole patent. The Examiner asserts that the smart digital offer object functions as the claimed first agent and that profile information serves as the user rule page. The Examiner asserts that the smart digital offer object functions as the claimed first agent having a triggering program to filter information and to determine whether the information is significant. (See generally, Final Office Action, page 4).

However, looking to O'Toole, col. 7, line 24 through col. 8, line 21, O'Toole teaches:

The client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object (step 118)...The client computer activates the smart digital offer object (step 120), and the smart digital offer object attempts to observe the parameters of the execution environment at the client machine, including the presence of coupons, and possibly other information such as a purchasing history recorded on the client computer....If the smart digital offer object attempts to observe the purchasing history or certain other user-specific information, the client computer asks the user whether the user wishes to reveal the information (step 122). The user indicates whether release of the information is authorized (step 124), and the smart digital offer object then examines the coupon (including the coupon's authenticator), digital receipts (including authenticators) and other

user-specific information authorized to be revealed by the user, and presents to the user an offer of a product or service (step 126)... When the user accepts the offer (step 128) the client computer sends a message to the offer-providing server indicating that the user has accepted the offer, or sends the message to an intermediary server that is trusted by the client computer to maintain the confidentiality of user-specific information and is trusted by the offer-providing server to verify the terms on which the offer was accepted (step 130)... The offer-providing server then fulfills the offer by causing the offered product or service to be provided to the user (step 134). (O'Toole, column 7, line 24 through column 8, line 21) (Emphasis Added).

Thus, as shown above, O'Toole teaches an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and further to ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline. This is markedly different from Appellant's claimed invention of independent claims 3 and 17 related to a user rule page containing information automatically obtained from the target computer by a first agent having a triggering program to filter information and to determine whether the information is relevant to a user rule page.

In the Final Office Action, the Examiner further asserts that the user rule page including at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer and a user profile including dynamic information related a user using the target computer is shown by O'Toole at column 7, lines 38-43; col. 8, lines 1-4; and col. 9, lines 18-28.

However, Appellant can nowhere find the teaching of these limitations in the previously quoted section of column 7. Further, col. 8, lines 1-4 cited by the Examiner teaches: "user profile information such as membership codes, user's age, user's income, and other demographic information certified by an independent authority with an authenticator." Whereas col. 9, lines 18-28 cited by the Examiner teach a "client computer 200 or agency computer 204 stores a client personal profile 206 containing demographic data, current shopping interest and preferences, contact addresses and other personal or semi-personal information...the client personal profile can include information that changes on a day-to-day basis, such as purchasing history (which may be recorded in accordance with the techniques described in the above-mentioned U.S. Patent Application Serial No. 08/328,133)..."

As described above, O'Toole teaches an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and further to ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline and some sort of user profile information related to demographic information, shopping interests, purchasing history, etc.

O'Toole quite clearly does not teach or suggest a user rule page containing information automatically obtained from the target computer by a first agent having a triggering program to filter information and to determine whether the information is relevant to a user rule page.

The Examiner further asserts in the Final Office Action, on page 5, that O'Toole's collection of rules for customizing targeted information based on a client's profile is equivalent to the claimed rule book...based on the user rule page.

However, based on the sections of O'Toole cited by the Examiner, it is Appellant's opinion that O'Toole does not teach, suggest, or render obvious Appellant's detailed claim limitations related to *a rule book to provide a rule based on the user rule page...the rule controlling the content to be transmitted from a database to the target computer...the rule stored in the form of a condition/action pair...wherein the user rule page includes at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer including information on web-sites visited and time spent by the user on the web-sites.* These limitations are simply not taught or suggested by O'Toole.

On page 5 of the Final Office Action, and in the Advisory Action, it is further alleged that O'Toole teaches Appellant's claim limitations related to a second agent that updates information in the user rule page based upon information received from the target computer and based upon an updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

In support of this, the Examiner cites column 7, lines 24-26, which states that the client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object. The Examiner also cites column 9, lines 22-61 of O'Toole

that relates to a client avatar located at the client computer which acts as an agent for the user by controlling the release of information from a client personal profile 206 to server computer 202. However, both the client avatar 210 and the client personal profile 206 are both located at the client computer not at a content provider. Moreover, the Examiner cites column 10, lines 18-28 of O'Toole which states that: "the server computer may use the subset of the client personal profile to customize other web-services offered to the user, including digital coupons, search services, and advertisements."

However, these citations by the Examiner nowhere teach, suggest, or render obvious a *second agent* that updates information (after a first agent) *in a user rule page* (which includes at least one of a *hardware profile* indicating hardware capabilities of the target computer, a *software profile* indicating software used by the target computer, and a *user profile including dynamic information* related to a user including information on web-sites visited and time spent by the user on the web-sites) and *based upon the updated user rule page finds new appropriate content including a second advertisement* that is transmitted to the computer.

As discussed above, because O'Toole does not teach or suggest all of Applicant's detailed claim limitations related to a user rule page containing information automatically obtained from the target computer by a first agent having a trigger program to filter information and to determine whether information is relevant to a user rule page...a rule book to provide a rule based on the user rule page...the rule controlling the content to be transmitted from a database to the target computer...wherein the user rule page includes at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information including information on web-sites visited and time spent by the user on the web-sites...and wherein a second agent updates information in the user rule page based on information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

Thus, O'Toole cannot render obvious Applicant's claimed invention of independent claims 3 and 17.

It appears that the Examiner somewhat recognizes that O'Toole does not teach or suggest all of the claim limitations of independent claims 3 and 17 and therefore relies on Davis, to, in hindsight, reconstruct Applicant's independent claims 3 and 17.

However, there is no motivation to modify O'Toole, which works well for its intended purpose of providing techniques for controlling transfers of information in computer networks, including transmitting smart digital offers based on information such as coupons and purchasing history stored at the computer receiving the offer. There is no motivation to modify O'Toole, with Davis, except to approximate Applicant's detailed claim limitations of independent claims 3 and 17.

As the Examiner states on page 7 of the Final Office Action, "O'Toole does not explicitly disclose how this confirmation of compatibility between the client and servers communication hardware and software is established; however, Davis teaches the monitoring of client activity in order to create a client profile that is used to target content, such as an ad to a user (column 4, lines 24-27)." However, the Examiner asserts that Davis teaches the ability to use an agent to obtain data regarding hardware characteristics of a target computer. Moreover, the Examiner asserts that Official Notice is taken that it is old and well-known in the art of computers to access a software profile (Final Office Action, page 8). Additionally, the Examiner recognizes that "O'Toole does not explicitly teach the profiling of the web-sites visited and time spent at each by a user; however, Davis makes up for this deficiency..." (Final Office Action, page 9).

Thus, Davis is cited merely to teach the ability of an agent that can be used to obtain data regarding the hardware characteristics of a target computer, and further to show that it has been known to track dynamic information including information on web-sites visited and time spent by the user on the web-sites. As the Examiner admits, Davis does not particularly teach or suggest a user rule page including a software profile indicating software used by the target computer; but merely states that Official Notice is taken that it is old and well-known in the art of computers to access a software profile.

As pointed out by the Federal Circuit, reliance solely on "skill in the art," is generally insufficient to modify a reference to reach an obviousness judgment. In *Al-Site*, the Federal Circuit stated: "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI Int'l, Inc.*, 50

USPQ2d 1161, 1171, (Fed. Cir. 1999) (emphasis added). Appellants respectfully submit that there is no teaching or suggestion in the two references, along with the skill in the art component (i.e. Official Notice), cited by the Office Action, in order to render obvious Appellant's independent claims 3 and 17.

Appellant respectfully submits that this is classic hindsight reconstruction. Further, the base reference O'Toole, as previously discussed does not teach or suggest the detailed claim limitations of independent claims 3 and 17, as discussed above.

Appellant respectfully submits that neither O'Toole and/or Davis, alone or in combination, teach or suggest: a user rule page containing information automatically obtained from a target computer by a first agent having a triggering program to filter information and to determine whether the information is relevant to the user rule page...a rule book to provide a rule based on the user rule page...the user rule page including at least one of a hardware profile, a software profile, and a user profile including dynamic information related to a user using the target computer including information on web-sites visited and time spent by the user on the web-site, and wherein a second agent updates information in the user rule page based on information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

Based on the foregoing, Appellant respectfully submits that there is no teaching or suggestion in O'Toole and Davis, along with ordinary skill in the art (i.e. Official Notice), to render obvious the limitations and interaction of the limitations of Appellant's claimed invention as set forth in Appellant's independent claims 3 and 17. Quite simply, there is no teaching or suggestion in either of these references, alone or in combination, with or without what would have been allegedly apparent to one skilled in the art, to teach, suggest, or render obvious the limitations and interaction of the limitations of Appellant's independent claims 3 and 17, *except for impermissible hindsight* even assuming the limitations were actually taught.

In view of the foregoing, Appellant respectfully submits that independent claims 3 and 17 are not rendered obvious by the hindsight combination of O'Toole, Davis, and what would have been allegedly known to one skill in the art (i.e. Official Notice), and these claims should be allowed. Appellant respectfully requests that the Board reverse the Examiner's decision as to

independent claims 3 and 17. With respect to the dependent claims, Appellant respectfully submits that these claims are allowable for being dependent upon allowable independent claims.

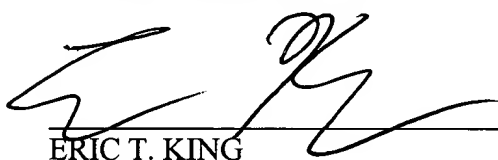
B. Conclusion

Appellant respectfully requests that the Board enter a decision overturning the Examiner's rejection of all pending claims, and hold that the claims are neither anticipated or rendered obvious by the prior art.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: May 28, 2004


ERIC T. KING
Reg. No. 44,188

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CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

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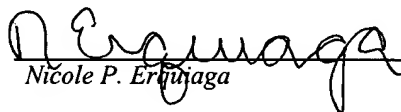
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IX. APPENDIX

The claims of the present application which are involved in this appeal are as follows:

1-2. (Canceled)

3. (Previously Presented) A system comprising:

a target computer to receive a content including an advertisement; and

a content provider coupled to the target computer via a network to transmit the content, the content provider comprising:

a user rule page containing information automatically obtained from the target computer by a first agent, the first agent having a trigger program to filter information and to determine whether the information is relevant to the user rule page;

a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair, the user rule page including at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web sites visited and time spent by the user on the websites; and

wherein a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

4. (Previously Presented) The system of claim 3 wherein the hardware profile includes a modem speed.

5. (Previously Presented) The system of claim 3 wherein the first agent uses an internet programming language.

6-16. (Canceled)

17. (Previously Presented) A system comprising:
a content provider transmitting a content including an advertisement via a network to a target computer, the content provider comprising:

a user rule page containing information being obtained automatically from the target computer by a first agent, the first agent having a triggering program to filter information and to determine whether the information is relevant to the user rule page;

a rulebook to provide a rule based on the user rule page, the rule controlling a content transmitted from a database to the target computer, the rule being stored in form of a condition-action pair, the user rule page including at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information related to a user using the target computer, the dynamic information including information on web sites visited and time spent by the user on the web sites; and

wherein a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

18. (Previously Presented) The system of claim 17 wherein the hardware profile includes a modem speed.

19-21. (Canceled)

22. (Previously Presented) The system of claim 17 wherein the content is transmitted in an internet protocol format.

23. (Previously Presented) The system of claim 17 wherein the software profile includes a software package and memory usage by the target computer.

24. (Previously Presented) The system of claim 3 wherein the hardware profile includes a type of processor, an amount of memory available, processor clock speed and memory usage on the target computer.

25. (Previously Presented) The system of claim 3 wherein the software profile includes a software package and memory usage by the target computer.

26. (Canceled)

27. (Previously Presented) The system of claim 17 wherein the rule page comprises a user profile including dynamic information related to a user using the target computer.

28. (Previously Presented) The system of claim 4 wherein the rule matches the content with the hardware characteristic of the target computer.

29. (Previously Presented) The system of claim 3 wherein the content is an advertisement banner.

30-31. (Canceled)

32. (Previously Presented) The system of claim 17 wherein the hardware profile includes a type of processor, an amount of memory available, processor clock speed, and memory usage on the target computer.

33-35 (Canceled)

36. (Previously Presented) The system of claim 27 wherein the dynamic information comprises information on web sites visited and time spent by the user.

37-39 (Canceled)

40. (Previously Presented) The system of claim 17 wherein the first agent uses an internet programming language.

41. (Previously Presented) The system of claim 3 wherein the content is transmitted in an internet protocol format.

42-44. (Canceled)

45. (Previously Presented) The system of claim 17 wherein the content is an ad banner.

46. (Previously Presented) The system of claim 3 wherein the first agent is an object code for a control residing on a web page.

47. (Previously Presented) The system of claim 46 wherein the control is transmitted with the web page while a dormant object code resides on a server.

48. (Previously Presented) The system of claim 3 wherein the target computer communicates with additional content providers, and wherein the target computer maintains several provider rule pages of the additional content providers.

49. (Original) The system of claim 48 wherein each provider rule page includes information from at least one of the additional content providers.

50-53 (Canceled)

54. (Previously Presented) The system of claim 17 wherein the first agent is an object code for a control residing on a web page.

55. (Original) The system of claim 54 wherein the control is transmitted with the web page while a dormant object code resides on a server.

56. (Previously Presented) The system of claim 17 wherein the target computer communicates with additional content providers, and wherein the target computer maintains several provider rule pages of the additional content providers.

57. (Original) The system of claim 56 wherein each provider rule page includes information from at least one of the additional content providers.